

REMARKS

Reconsideration of the above-identified application is respectfully requested.

In the Official Action, the Examiner first rejected Claims 1-4 under 35 U.S.C. §112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Particularly, the Examiner indicates that the phrase recited in Claim 1, lines 7-9 should read, “a collar oxide region formed on one or more remaining portions of each deep trench”. The Examiner is respectfully requested to reconsider as the Claim 1 in applicants prior amendment submitted May 9, 2006, had been amended to recite the exact phraseology as indicated by the Examiner in the present Office Action. That is, Claim 1, lines 7-9, was already amended in applicants’ prior response to recite

“a collar oxide region formed on one or more remaining portions of each deep trench...”.

In the Official Action, the Examiner then rejected Claims 1-4 under 35 U.S.C. §102(e), as allegedly anticipated by Gruening et al. (U.S. Patent No. 6,437,381)(“Gruening”). The Examiner notes correctly that this is assigned to the same (common) assignee as the present application.

With respect to the Examiner’s rejection of Claims 1-4 as being unpatentable over Gruening, Gruening, while being filed April 27, 2000, qualifies as prior art under United States Code 35 U.S.C. §102(e)/103. Accordingly, it is noted that Gruening may not be prior art as to the present application because Gruening and the present application have been assigned to the same corporation, International Business Machines, Corp..

That is, the cited reference to Gruening, while being filed April 27, 2000 qualifies this reference as prior art under 35 U.S.C. §102(e). However, Applicants note that Gruening is not prior art as to the present application because Gruening and the present application are assigned to the same corporation, International Business Machines Corp. Applicants submit that the American Inventors Protection Act of 1999, enacted November 29, 1999, had amended 35 U.S.C. §103(c) to recite essentially that subject matter developed by another person which

qualifies as prior art under 35 U.S.C. §102(e) does not preclude patentability where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an application of assignment to the same person.

That 35 U.S.C. §102(e)/ 103(c) applies to the instant application is established by the fact that Gruening was filed April 27, 2000 and pending on or filed after November 29, 2000.

That the claims of the present application are patentable over the rejection of record is established by the fact that Gruening is, on its face, assigned to International Business Machines Corporation. The present application, which is a continuation of U.S. Patent Serial No. 09/832,605 filed on April 11, 2001 (now U.S. Patent No. 6,809,368 issued Oct. 26, 2004) was filed on February 10, 2004, and at that time, was also assigned to International Business Machines Corporation, as evidenced by the Assignment recorded by the USPTO on April 11, 2001 at Reel 011740, Frame 0042.

U.S. Patent 6,437,381 issued to Gruening issued August 20, 2002. The present application is entitled to the benefit of the filing date of April 11, 2001. As such, the outstanding rejection of the claims of the present application applies the Gruening patent predicated upon its availability as a reference under 35 U.S.C. §102(e) in that this is the only subsection of 35 U.S.C. §102 whose requirements are met by this patent. In view of the requirements of 35 U.S.C. §103(c), as amended November 29, 1999, which apply to the instant application, the Gruening reference cannot preclude patentability under 35 U.S.C. §102(e), the section upon which the claims of the present application have been rejected. Thus, the Claims 1-4 of the present application are patentable over the outstanding rejection of record. Reconsideration and removal of this ground of rejection is therefore deemed appropriate. Such action is respectfully urged.

Based on the foregoing, claims 1-4 herein are in condition for allowance. Issue of a Notice of Allowance for the application is therefore requested.

If any issues remain outstanding, incident to the formal allowance of the application, the Examiner is requested to contact the undersigned attorney at (516) 742-4343 to discuss same, in order that this application may be allowed and passed to issue at an early date.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Steven Fischman', with a long horizontal flourish extending to the right.

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